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10/713,429

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EXAMINER

LEROUX, ETIENNE PIERRE

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PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/713,429	Applicant(s) ROLLIN ET AL.	
	Examiner Etienne P. LeRoux	Art Unit 2161	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 29 January 2009.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 28 and 30-63 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 28 and 30-63 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input checked="" type="checkbox"/> Other: <u>Amendment to the Specification</u> |

Claim Rejections - 35 USC § 112

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claim 28 and 30-63 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

Claim 28 recites “storing the selected content data on the PSD in association with a new user profile.” The above limitation is not supported in the specification, particularly “new user profile.” The only “new” subject matter in the specification is the following:

Detail Description Paragraph:

[0040] According to additional aspects of the invention, each time he saves changes to the document, these changes are automatically synchronized to the Memory Stick.RTM. by the system. While he is working on the notebook computer, the user receives an e-mail from his wife that has a new digital photograph of his family attached to it. The user decides to make this new photograph the desktop background, and replaces the current background image with the new

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image received from his wife. This change is also detected by the system and is automatically replicated on the Memory Stick.RTM..

Examiner will interpret "new user profile" to mean "new content."

Dependent claims 3-39, 41-51 and 52-63 are rejected for, at least being dependent from a rejected base claim.

Claim Objections

Claim 30 is objected to because claim 30 recites "The method according to claim 30"
Appropriate correction is required.

Claim Status

Claims 28, and 30-63 are pending.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 28, 30-35, 40-47 and 52-59 are rejected under 35 U.S.C. 103(a) as being unpatentable over Carman (US 2003/0046567) in view of Stegink et al (US2004/0215278).

Regarding claim 28, 40 and 52, Carman discloses:

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detecting a connection [Fig 4, step 403, recognize smart memory card, paragraph 35] of a Portable Storage Device (PSD) [Fig 2, memory card 100, paragraph 24] to a computing device [Fig 2, cellular telephone 200, paragraph 24]

upon detecting the connection of the PSD, scanning the PSD for an indication of an existing user profile [paragraph 36, consumer enters password or PIN to unlock the card] containing data files [paragraph 49, Fig 6, username, password and URL stored in table format], application settings [paragraph 52, memory card may act as a key] and user environment settings, wherein the user environment settings comprise a user's desktop configuration, start menu configuration or other operating system shell configurations [paragraph 34, computer's operating system goes through an automatic recognition process to load the driver for the memory card]

Carman discloses in response to detecting that no existing user profile is found on the PSD, automatically launching a user profile connection that enables the user to create a user profile on the PSD [paragraph 31].

Carman discloses the elements of the claimed invention as noted above but does not disclose launching a wizard. Stegink discloses launching a wizard [Stegink, paragraph 14, installation wizard software on the memory stick may automatically load and present screen prompts for inputs from the user]. It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Carman to include launching a wizard as taught by Stegink for the purpose of for the purpose of automatically loading and presenting screen prompts for inputs from the user [paragraph 14].

The combination of Carman and Stegink discloses receiving input from the user profile configuration wizard from the user selecting which content data will be synchronized between

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the PSD and the computing device [Carman, paragraph 27, the telephone's browser or operating system then stores both the username and password with the URL of the web page into the memory card's memory]

The combination of Carman and Stegink discloses storing the selected content data on the PSD in association with the user profile [Carman, paragraph 27, the telephone's browser or operating system then stores both the username and password with the URL of the web page into the memory card's memory]

The combination of Carman and Stegink discloses in response to the user input synchronizing the selected content data between the PSD and the computing device [Carman, paragraph 27, the telephone's browser or operating system then stores both the username and password with the URL of the web page into the memory card's memory]

Regarding claim 30, 42, 54, the combination of Carman and Stegink discloses wherein the content data comprises a plurality of different types of data [Carman, paragraphs 40, 41]

Regarding claim 31, 43, 55, the combination of Carman and Stegink discloses wherein the plurality of different types of data include one or more contacts, multimedia files, calendar data, and documents [Carman, paragraphs 40, 41]

Regarding claim 32, 44, 56, the combination of Caramn and Stegink discloses wherein for each of the plurality of types of data, the user may select all, some, or none of the data [Caramn, paragraph 27]

Regarding claim 33, 41, 45, 53, 57, the combination of Carman and Stegink discloses the step of synchronizing the selected content data with data on a later-connected PSD [Carman, paragraph 41]

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Regarding claim 34, 46, 58, the combination of Carman and Stegink discloses wherein the content data comprises user settings [Carman, paragraph 27]

Regarding claim 35, 47, 59, the combination of Carman and Stegink discloses prompting the user to select for synchronization all, some or none of the user settings [Carman, paragraph 41]

Regarding claim 50, 62, the combination of Mitchelmore and Kaplan discloses determining whether there is sufficient memory available on the PSD to stores a user profile [Mitchelmore, paragraph 5].

Claims 36, 48 and 60 are rejected under 35 U.S.C. 103(a) as being unpatentable over the combination of Carman and Stegink in view of Ananian (Pub No US 2003/0028451), hereafter Ananian.

Regarding claim 36, 48, 60, the combination of Carman and Stegink discloses the elements of the claimed invention as noted above but does not disclose the step of displaying, if the user chooses some of the user settings for synchronization, a list of user settings to the user. Ananian discloses the step of displaying, if the user chooses some of the user settings for synchronization, a list of user settings to the user [claim 17]. It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the above combination of references to include above limitation as taught by Ananian for the purpose of managing personalized user profiled catalogs [abstract] .

Regarding claim 37, 49, 61, the combination of Carman, Stegink and Ananian discloses the elements of the claimed invention as noted above but does not disclose wherein each item in

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the list of user settings is accompanied by a checkbox that, if check, selects the item for synchronization. It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the above combination of references to include wherein each item in the list of user settings is accompanied by a checkbox that, if check, selects the item for synchronization for the purpose of providing a quick and easy means for the user to make a selection of a desired action.

Claims 38, 39, 50, 51, 62, 63, are rejected under 35 U.S.C. 103(a) as being unpatentable over the combination of Carman and Stegink in view of Horvitz (US 2003/0154282).

Regarding claim 38, 50, 62, the combination of Carman and Stegink discloses the elements of the claimed invention as noted above but does not disclose determining whether there is sufficient memory available on the PSD to store a user profile. Horvitz discloses determining whether there is sufficient memory available on the PSD to store a user profile [claim 41]. It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the above combination of references to include determining whether there is sufficient memory available on the PSD to store a user profile as taught by Horvitz for the purpose of determining whether to change the storage capacity [claim 41].

Regarding claim 39, the combination of Carman, Stegink and Horvitz discloses wherein if there is sufficient memory available on the PSD to store a user profile, selecting a portion of memory on the PSD for storing the user profile and formatting the portion of memory for use as a user profile [Carman, paragraph 27]

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Regarding claim 51, 63, the combination of Carman, Stegink and Horvitz discloses the elements of the claimed invention as noted above but does not disclose wherein if there is not sufficient memory available on the PSD to store a user profile, offering to free up storage space on the PSD by deleting files stored on the PSD selecting a portion of memory on the PSD for storing the user profile and formatting the portion of memory for use as a user profile. It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the above combination of references to include wherein if there is not sufficient memory available on the PSD to store a user profile, offering to free up storage space on the PSD by deleting files stored on the PSD selecting a portion of memory on the PSD for storing the user profile and formatting the portion of memory for use as a user profile for the purpose of conserving resources by making the best utilization of the present memory.

Response to Arguments

Applicant's arguments filed 1/29/2009 have been fully considered but they are not persuasive.

Applicant states that “the Carman reference fails to teach or suggest detecting a connection of a Portable Storage device (PSD) to a computing device, and upon detecting the connection of the PSD, scanning the PSD for an indication of an existing user profile containing data files, application settings and user environmental settings wherein the user environmental settings comprise a user’s desktop configuration, start menu configuration or other operating system shell configurations.”

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Examiner is not persuaded. Above claim 28 limitations are accurately mapped to the prior art made of record in the above Office action.

Applicant states “It is respectfully submitted that the Carman reference does not teach or suggest scanning a storage device for a user profile containing data files, application settings and user environment settings.

Examiner is not persuaded. During examination examiner is required to give claim language its broadest reasonable interpretation in light of the specification unless the specification provides a specific and deliberate definition of the claim language. The specification does not (emphasis added) provide a specific and deliberate definition of “user profile containing data files, application settings and user environment settings” and thus examiner maintains that examiner’s broadest reasonable interpretation in light of the specification is proper. Above claim 28 limitations are accurately mapped to the prior art made of record in the above Office action.

Applicant states “It is respectfully submitted that the Stegink reference fails to cure the deficiencies of the Carman reference as the Stegink reference fails to teach or suggest upon detecting a connection of a Portable Storage Device (PSD) to a computing device, scanning the PSD for an indication of an existing user profile containing data files, application settings and use5 e4nvironmental settings, wherein the user environmental settings comprise a user’s desktop configuration, start menu configuration or other operating shell configurations.”

Examiner is not persuaded. In response to applicant's arguments against the references individually, one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208

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USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986).

Furthermore, above claim 28 limitations are accurately mapped to the prior art made of record in the above Office action.

Applicant argues “the Stegink reference fails to teach or suggest in response to detecting that no existing user profile is found on the PSD, automatically launching a user profile connection wizard that enables the user to create a user profile on the PSD, wherein the user profile configuration wizard allows a user to select which content data will be synchronized between the PSD and the computing device.”

Examiner is not persuaded. Examiner is not persuaded. During examination examiner is required to give claim language its broadest reasonable interpretation in light of the specification unless the specification provides a specific and deliberate definition of the claim language. The specification does not (emphasis added) provide a specific and deliberate definition of “automatically launching a user profile connection wizard that enables the user to create a user profile on the PSD.” In fact “automatically launching” is not (emphasis added) found in the specification whatsoever. Therefore, examiner maintains that examiner’s broadest reasonable interpretation in light of the specification is proper. Above claim 28 limitations are accurately mapped to the prior art made of record in the above Office action.

The above claim 28 limitations have been accurately mapped to the prior art of record in above Office action.

Furthermore, applicant in pages 17-30 continues to argue the limitations of the claimed invention. Applicant is referred to above Office action. Furthermore, applicant continues to

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attack the references individually. Examiner is not persuaded. In response to applicant's arguments against the references individually, one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986).

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Etienne P. LeRoux whose telephone number is (571) 272-4022. The examiner can normally be reached on Monday through Friday, 8:00 am - 4:30 pm.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Apu Mofiz can be reached on (571) 272-4080. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Etienne P LeRoux/
Primary Examiner, Art Unit 2161

2/11/2009